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| RALPH E. JOCKE walker & jocke LPA 231 SOUTH BROADWAY MEDINA, OH 44256 | | | EXAMINER CAMPEN, KELLY SCAGGS | |
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5 BEFORE THE BOARD OF PATENT APPEALS
6 AND INTERFERENCES
7

8
9 *Ex parte* JAY PAUL DRUMMOND, BOB A. CICHON,
10 MARK D. SMITH, DAVID WEIS, JAMES R. CHURCH,
11 and MIKAL R. GILGER
12

13 Appeal 2008-1839
14 Application 09/578,291
15 Technology Center 3600
16

17 Decided: ¹ June 1, 2009
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19

20 *Before:* MURRIEL E. CRAWFORD, ANTON W. FETTING, and JOSEPH
21 FISCHETTI, *Administrative Patent Judges.*
22
23 CRAWFORD, *Administrative Patent Judge.*
24

25 DECISION ON APPEAL
26

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a non-final rejection of claims 1 to 32. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented an automated banking machine apparatus and system that is capable of use in a wide area network (Spec. 1).

Claim 1 under appeal reads as follows:

1. A method comprising the steps of: a) determining through operation of an automated banking machine, data corresponding to an entity with which a customer operating the machine has an account; b) providing through an output device on the automated banking machine at least one output uniquely corresponding to the entity with which the customer has the account.

The prior art relied upon by the Examiner in rejecting the claims on appeal are:

| | | |
|----------|-----------|--------------|
| Anderson | 5,706,442 | Jan. 6, 1998 |
|----------|-----------|--------------|

LA Times Staff Writers, *Trade it Yourself Bank Machines Make a Debut*, L.A. Times, Oct. 6, 1994, (Home Edition Business Section) at 1 Pt. D, Col. 5.

Leon, Mark, *TP-Monitor Vendors Spin Web Features*, InfoWorld v18n27 Jul. 1, 1996 at 37.

The Examiner rejected claims 1 to 32 under 35 U.S.C. § 102(b) as being anticipated by or in the alternative under 35 U.S.C. § 103 as obvious over LA Times.

The Examiner rejected claims 1 to 32 under 35 U.S.C. § 103(a) as being unpatentable over LA Times in view of Infoworld or Anderson.

ISSUES

The Appellants contend that the Examiner's finding that the Citibank ATM described in LA Times is considered to possess all normal components and component interrelationships of an ATM machine is based on improper speculation. The first issue is: have Appellants shown that the Examiner erred in finding that LA Times inherently discloses an ATM that determines data corresponding to an entity with which a customer has an account and provides at least one output uniquely corresponding to the entity and is able to provide account access, transfer funds and dispense statements?

The second issue is: have the Appellants shown that the Examiner erred in finding that Infoworld and Anderson disclose a browser in operative connection with an ATM?

FINDINGS OF FACT

LA Times discloses that Citibank is offering full-scale brokerage services on ATM machines that will be used for banking and for brokerage services. The Citibank ATMs have separate menus for banking and brokerage services. LA Times also discloses that Wells Fargo allowed customers using ATMs to buy and sell proprietary mutual funds and that Wells Fargo chose not to provide stock quotes and other trading options because the bank was concerned that the ATM lines would be clogged with customers checking stock prices. Citibank is not concerned about this problem. The problem of clogged ATM lines did not materialize during the Citibank pilot program of the new ATM.

The Examiner found that the Citibank ATM disclosed in LA Times inherently includes the banking functions of account access, funds transfer,

1 cash, receipt and statement dispensing, and inherently possesses all normal
2 components and component interrelationships of an ATM machine such as a
3 card reader, currency output device and currency sheet dispenser, a receipt
4 output device including a receipt sheet dispenser and a computer in operative
5 connection with the output devices and the currency sheet dispensers (Ans.
6 3-4).

7 An ATM determines the entity with which the customer operating the
8 machine has an account by determining which bank the customer has an
9 account with. An ATM provides, through an output device on the ATM,
10 at least one output uniquely corresponding to the entity with which the
11 customer has an account by providing, for example, a receipt after a banking
12 transaction or in response to a balance inquiry.

13 Infoworld discloses that NCR has developed enhancements to its Top
14 End middleware. A Java client was delivered to the Top End transaction-
15 processing monitor. The Top End client code runs on PCs and makes one
16 or 10,000 machines look as if they are local to a user's computing resource.
17 The client code which runs on PCs is downloaded into the user's web
18 browser to establish a direct link to the Top End back-end application,
19 thereby setting up a private TCP/IP connection that makes the user's
20 computer look as if it is a local ATM system. The web browser in Infoworld
21 is located in the user's computer, not in the ATM,

22 Anderson discloses a system for on-line financial services which uses
23 a browser interface (col. 2, ll. 40 to 47). Anderson does not disclose that the
24 browser interface is in operative connection with an ATM.

PRINCIPLES OF LAW

When the claimed and prior art products appear to be identical or substantially identical, the Examiner can require an applicant to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *See In re Best*, 562 F.2d 1252, 1255 (CCPA 1977); *see also In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990) (“[W]hen the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.”). As stated in *In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980) (quoting *In re Best*, 562 F.2d at 1255):

ANALYSIS

Anticipation by LA Times

We are not persuaded of error by the Examiner by Appellants’ argument that Examiner’s contention that the Citibank ATM described in LA Times is considered to possess all normal components and component interrelationships of an ATM machine is based on improper speculation. The Examiner has found that LA Times inherently discloses an ATM that determines data corresponding to an entity with which a customer operating the machine has an account and provides at least one output uniquely corresponding to the entity with which the customer has an account. As we found above, an ATM performs these steps by identifying the bank with which the customer has an account and providing a receipt in response to a banking transaction or inquiry. The Examiner has a sound basis for finding that the Citibank ATM described in LA Times performs these steps, as they

1 are steps that are traditionally performed by an ATM. We do not agree with
2 the Appellants that there would be no need to determine the entity with
3 which the customer has an account because the machines only work for
4 Citibank customers. LA Times does not state that the Citibank ATMs are
5 atypical in that they do not work with customers with accounts in other
6 banks. Appellants argue that the Citibank ATM described in LA Times is
7 not a typical ATM with normal components because the ATM is specially
8 designed. We do not agree. While LA Times does disclose that the
9 Citibank ATM is specially designed to include brokerage services, it
10 nonetheless is described as a typical ATM. For example, LA Times states
11 that the problem anticipated by Wells Fargo of regular banking customers
12 waiting in line for the ATM behind someone with a large portfolio did not
13 materialize during Citibank's pilot program. As such, the Examiner had a
14 sound basis for finding that the Citibank ATM described in LA Times was a
15 typical ATM which determines the entity with which the customer has an
16 account and provides an output that uniquely corresponds to the entity with
17 which the customer has an account. Since the Examiner has a sound basis
18 for finding that these steps are inherently performed by the Citibank ATM
19 described in LA Times, the burden shifted to the Appellants to prove that the
20 Citibank ATM did not perform these steps. The Appellants have not
21 provided any evidence that these steps are not inherent in the Citibank ATM.
22 Therefore, the burden is not met.

23 In view of the foregoing, we will sustain the Examiner's rejection of
24 claim 1.

We will also sustain the rejection as it is directed to claims 2 to 4, 28 and 29 because the Examiner has a sound basis for finding that the Citibank ATM described in LA Times, like a typical ATM, includes a card reader that reads indicia on a bank card; provides a visual output corresponding to the entity; and includes a cash dispenser and the Appellants have not provided evidence that this is not the case.

We will not sustain this rejection as it is directed to claim 5 because the Examiner has not established that LA Times describes processing at least one document through a browser. In fact, the Examiner admits that LA Times is silent on whether a browser is used in the Citibank ATM (Ans. 5). In addition, the Examiner has made no findings regarding whether the Citibank ATM disclosed in LA Times inherently includes a browser.

In view of the foregoing, we will not sustain this rejection as it is directed to claim 5 and claims 6 to 7 dependent thereon. We will also not sustain this rejection as it is directed to claims 8 to 27, 30 to 32 because each of these claims requires the use of a browser.

Obviousness in view of LA Times

We will sustain the rejection as it is directed to claims 1 to 4, 28 and 29 because as we stated above there is sound basis to find that the Citibank ATM described in LA Times inherently includes the elements and steps recited in these claims. In addition, as LA Times discloses a Citibank ATM, LA Times suggests an ATM that includes the elements recited in these claims as the steps and elements are typical in an ATM.

We will not sustain the rejection directed to claims 5 to 27 and 30 to 32 because each of these claims requires the use of a browser which is neither disclosed expressly or inherently or suggested by LA Times.

Obviousness in view of LA Times and Infoworld or Anderson

The Examiner relies on Infoworld and Anderson for teaching a browser interface through which an ATM functions. However claims 1 to 4, 28 and 29 do not recite a browser. As such, we will sustain the rejections as directed to these claims for the reasons stated above in our discussion of the anticipation and obviousness rejections of these claims based on the teachings of LA Times alone.

We will also sustain the rejection of claim 5 over LA Times in view of Infoworld. Claim 5 generally recites “a browser operating in a computer in operative connection with an automated banking machine.” We found that Infoworld discloses that the client code which runs on PCs is downloaded into the user’s web browser to establish a direct link to the Top End back-end application, thereby setting up a private TCP/IP connection that makes the user’s computer look as if it is a local ATM system. The language of claim 5 is thus sufficiently broad enough to encompass the off-site computer which, has the browser, to be in operative connection with the ATM through its TCP/IP connection. We will also sustain this rejection as it is directed to claims 6 and 7 which are dependent on claim 5 because the Appellants do not argue the separated patentability of these claims. We note that Appellant's statements directed to claims 6 and 7 merely restate the limitations of the claims and state that they are not taught by the art. We do

not consider Appellant's statements regarding claims 6 and 7 to be a separate argument for patentability under 37 C.F.R. § 41.37 (c)(1)(vii).

Claims 8 and 19, and claims 9 to 18, 20 to 27, 30 to 32 dependent thereon require that the browser is included in the banking machine. We have found the web browser in Infoworld is located in the user's computer, not in the ATM, since the Examiner has not provided any reasons to the contrary. As such, Infoworld does not disclose a browser in the ATM. Therefore, we will not sustain the rejection of claims 8 to 27, 30 and 32 over LA Times in view of Infoworld.

In addition, we agree with the Appellant that Anderson does not disclose or suggest an ATM or that the described browser is in operative connection to an ATM. As such, we will not sustain the rejection of claims 5 to 27 and 30 to 32 as being unpatentable over LA Times in view of Anderson.

CONCLUSION OF LAW

On the record before us, Appellants have shown that the Examiner erred in rejecting claims 8 to 27 and 30 to 32. The Appellants have not shown that the Examiner erred in rejecting claims 1 -7, 28 and 29.

AFFIRMED-IN-PART

JRG

RALPH E. JOCKE
Walker & Jocke LPA
231 SOUTH BROADWAY
MEDINA, OH 44256